

Appl. No. 10/730,438
Docket No. CM2713Q
Amdt. dated January 19, 2010
Reply to Office Action mailed on October 19, 2009
Customer No. 27752

REMARKS

Claim Status

Claims 1-11 are pending in the present application. No additional claims fee is believed to be due.

Claims 1-3, 5, 6, 10 and 11 are amended herein. Support for the amendment is found in the specification at, *inter alia*, page 10, lines 17-25.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 U.S.C. §103(a) Over Schleinz et al. In View Of Burazin et al.

Claims 1-4, 7, 10 and 11 stand rejected under 35 U.S.C. §103(a) over Schleinz et al. (U.S. Pat. No. 5,458,590) in view of Burazin et al. (U.S. App. Pub. No. 2002/0112832). Applicants respectfully request reconsideration.

Applicants respectfully submit, first, that the references do not disclose all elements of Applicants' claims; and second, that a showing of a teaching, suggestion or motivation to combined the cited references has not been shown.

As discussed below, Applicants believe that Claim 1 is patentable over the prior art references most recently cited. If Claim 1 is patentable, it follows that the remaining claims, being narrower in scope, are patentable as well. Therefore, without waiving any arguments they may otherwise have, Applicants defer arguments concerning rejection of Claims 5 and 6 over Schleinz et al. in view of Burazin et al., further in view of McCormack et. al. (U.S. Pat. No. 6,719,742) (Office Action at ¶29).

A. Requirements for *Prima Facie* Case of Obviousness

1. *Claimed Invention As A Whole Must Be Considered.*

Under MPEP §2142, the Office bears the burden of factually supporting an asserted *prima facie* conclusion of obviousness. In determining the differences between

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the cited art and the claims, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *See, e.g., Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537; 218 U.S.P.Q. 871 (Fed. Cir. 1983). If the Office does not demonstrate *prima facie* unpatentability, then without more, the Applicant is entitled to the grant of the patent. *See In re Oetiker*, 977 F.2d 1443, 1445; 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992).

2. *All Claim Elements Must Be Taught Or Suggested By Prior Art.*

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Office must show that all of the claim elements are taught or suggested in the prior art. *See, e.g., CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342; 68 U.S.P.Q.2d 1940 (Fed. Cir. 2003).

3. *A Teaching, Motivation or Suggestion to Combine the Cited References Must be Found in the Prior Art.*

[A] patent [claim] composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727, 1741, 82 U.S.P.Q.2D 1385 (2007).

Accordingly,

a flexible TSM test remains the primary guarantor against a non-statutory hindsight analysis *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) ("[A]s the Supreme Court suggests, a flexible approach to the TSM test prevents hindsight and focuses on evidence before the time of invention."). The TSM test, flexibly applied, merely assures that the obviousness test proceeds on the basis of evidence—teachings, suggestions (a tellingly broad term), or motivations (an equally broad

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term)—that arise before the time of invention as the statute requires. As KSR requires, those teachings, suggestions, or motivations need not always be written references but may be found within the knowledge and creativity of ordinarily skilled artisans.

Ortho-McNeil Pharmaceutical, Inc. v. Mylan Labs., Inc., 520 F.3d 1358, 1364-1365; 86 U.S.P.Q.2D 1196 (Fed. Cir. 2008) (judgment of nonobviousness and infringement affirmed). The lack of evidence of a motivation to combine is a critical defect in an obviousness conclusion, because there must be some suggestion, motivation, or teaching in the prior art whereby the person of ordinary skill would have selected the components that the inventor selected and use them to make the new device. *Golight, Inc. v. Wal-Mart Stores, Inc.*, 355 F.3d 1327, 1336; 69 U.S.P.Q.2d 1481, 1488 (Fed. Cir. 2004).

However,

. . . [t]here is no suggestion to combine [references] . . . if a reference teaches away from its combination with another source. *See id.* at 1075, 5 U.S.P.Q.2D (BNA) at 1599. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant . . . [or] if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q.2D (BNA) 1130, 1131 (Fed. Cir. 1994). If when combined, the references "would produce a seemingly inoperative device," then they teach away from their combination. *In re Spinnoble*, 56 C.C.P.A. 823, 405 F.2d 578, 587, 160 U.S.P.Q. (BNA) 237, 244 (CCPA 1969); *see also In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984) (finding no suggestion to modify a prior art device where the modification would render the device inoperable for its intended purpose).

Tec Air, Inc. v. Denso Mfg. Michigan Inc., 192 F.3d 1353, 1359-1360; 52 U.S.P.Q.2d 1294 (Fed. Cir. 1999). "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art." *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve*,

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Inc., 796 F.2d 443, 448, 230 U.S.P.Q. 416 (Fed. Cir. 1986), quoting *In re Wesslau*, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965).

B. Analysis

1. *The Combination of Cited References Does Not Teach or Suggest All Elements of Applicants' Claims.*

Current Claim 1 recites a disposable article selected from baby diapers, pull-on diapers, pants or adult incontinence diapers comprising, *inter alia*, a backsheet that comprises at least one polymeric film and at least one nonwoven web formed of fibers, wherein said polymeric film and said nonwoven web each have two major surfaces, said polymeric film comprises a polymeric film material, and said nonwoven web fibers comprise a polymeric nonwoven web material, wherein at least one of said polymeric film material or said polymeric nonwoven web material is color-pigmented by one or more pigments mixed thereinto prior to formation of said polymeric film or said nonwoven web, and wherein at least one of said polymeric film or said nonwoven web has visually discernible printed designs, said printed designs being provided by printing a pigmented ink onto at least one of said major surfaces of at least one of said polymeric film or said nonwoven web, and said polymeric film being joined in an overlaying region across at least part of one of its major surfaces to at least part of an adjacent major surface of said nonwoven web to form said backsheet, and wherein said backsheet in said overlaying region has an L Hunter value on the Hunter scale for darkness/lightness-appearance from 10 to 75, an "a" value for red/green-appearance from about -50.0 to about +50.0 and a "b" value for yellow/blue-appearance from about -50.0 to about +50.0, in the areas outside the printed designs. By dependency, each of the remaining claims includes all of these elements.

Without waiving any other arguments they may have, Applicants submit that neither Schlein et al. nor Burazin et al. does teaches or suggests a composite backsheet (*i.e.*, combination of polymer film and nonwoven) having printed ornamental designs, with an L Hunter value on the Hunter scale for darkness/lightness-appearance from 10 to

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75, an “a” value for red/green-appearance from about –50.0 to about +50.0 and a “b” value for yellow/blue-appearance from about –50.0 to about +50.0, in the areas outside the printed ornamental designs.

Schleinz et al. addresses inks and the crockfastness of inks after printing. It is silent concerning the coloration (expressed in L Hunter value) of a substrate upon which printing is done, in areas outside the printing.

Burazin et al. teaches a paper substrate having printed patterns thereon. Burazin et al. teaches HunterLab values for *ink* used to *print patterns* on the paper. It does not, however, teach any particular HunterLab values for *areas of the paper outside the printed patterns*. (See, e.g., Burazin et al. at ¶0025 (“the paper product and the masking pattern imparts a two-color camouflage to the sheet, the two colors being the color of the sheet (*typically white*) and the color of the [printing] ink.” (Emphasis added.))) Regarding coloration of the substrate upon which printing is done, Burazin et al. only mentions that it is “typically white.” (*Id.*)

For this reason, Applicants respectfully submit that the combination of Schleinz et al. and Burazin et al. does not teach or suggest all elements of Applicants’ claims, and therefore, does not support a *prima facie* conclusion of obviousness of the claims.

2. *A Teaching, Motivation or Suggestion for the Combination of the Cited References Has Not Been Established.*

Schleinz et al. addresses the problem of crockfastness of printing of products such as diapers. There is no mention in Schleinz of a problem of translucency or to look for ways to address a problem of translucency – and thus, no teaching, motivation or suggestion to consult other art, within the scope of materials used for diapers or outside that scope – to address translucency.

Burazin et al. addresses a problem of translucency of paper products (¶0017; ¶0050), through *printing a masking pattern* thereon. However, Burazin et al. is silent concerning whether such a problem exists outside the realm of paper products, and there

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is no teaching, motivation or suggestion within Burazin et al. that the technology it discloses has any application outside that realm.

The Office states that “[o]ne would be motivated to modify Schleinz with the L*a*b values as taught by Burazin to mask an absorbent product since both Schleinz and Burazin distract a user with colored printing.” Applicants respectfully submit that this statement contains a premise has not been shown to have evidentiary support. There is no suggestion in Schleinz et al. that some problem that might be addressed by some other teachings relating to the need for masking, exists. There is no evidence provided that applying teachings of Burazin et al. to Schleinz et al. would have benefits or enhance the Schleinz et al. product.

Moreover, elsewhere within prior art previously cited by the Office in this prosecution, it is suggested that a backsheet for an article of the type of Applicants’ claims (*e.g.*, diapers) having colors, outside printed areas, falling within the ranges of Applicants’ claims, *would be undesirable*. (*See* PTC Application No. WO 99/32164 (by Tao et al.), at page 2, lines 23-26 (“a high degree of whiteness, *i.e.*, the visual appearance of the white color of the article as seen by the consumer, is very important to the consumer”.) Thus, evidence of record teaches away from Applicants’ claimed invention, and no evidence of record teaches, suggests or motivates a combination of Burazin et al. with Schleinz et al., and modification of Schleinz et al., in a manner that would bring it within the scope of Applicants’ claims.

In summary, Schleinz et al. contains no suggestion of a combination with other art to address a problem of translucency; Burazin et al. contains no suggestion of a problem of translucency in articles such as diapers, or that the technology it discloses has applicability outside paper products such as facial tissue; and elsewhere in the prior art it is suggested that coloring a diaper backsheet (outside printed regions) to the Hunter L values of Applicants’ claims would be undesirable.

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For these reasons, Applicants respectfully submit that a teaching, motivation or suggestion of a combination of Schleinz et al. and Burazin et al. has not been established.

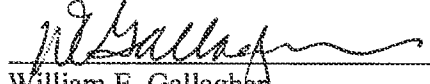
Conclusion

This response represents an earnest effort to place the present application in proper form for allowance. In view of the foregoing, entry of the amendments presented herein, reconsideration of this application, and allowance of the pending claims are respectfully requested.

Respectfully submitted,

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